

II. Remarks

A. Status of the Claims

Claims 30-36, 38, and 44-86 are pending. Claims 1-29, 37, and 39-43 are cancelled without prejudice to the subject matter contained therein. Support for the above claim amendments is found throughout the specification and claims as originally filed. No new matter is added.

Applicants have good and sufficient reasons why these remarks and amendments are necessary and why these remarks were not presented earlier. These remarks and amendments place the application in condition for allowance, or at least reduce the issues for appeal. Based on the above amendments and following remarks, Applicants respectfully request the Examiner reconsider all present rejections and that they be withdrawn.

B. Examiner Interview Summary

Applicants would like to thank Examiner Karpinsky and Supervisory Examiner Richter for the interview conducted with Applicants' representatives on July 14, 2011. Applicants' representatives discussed the rejections of record and cited references. The Examiner indicated that amendments to the method claims addressing the patient population may overcome the rejections. Further to the interview, Applicants provide amendments and remarks herein.

C. The Rejections Under 35 U.S.C. § 103(a) Should Be Withdrawn

Claims 1, 2, 4, 5, 10-12, 16-20, 22, 23, 25, 28, 30, 31, 39, and 42-45 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over United States Patent No. 6,241,998 to Muchin ("Muchin") in view of United States Patent No. 6,037,280 to Edwards et al. ("Edwards"). Claims 33-36 and 38 stand rejected under 35 U.S.C. § 103(a) in view of Muchin, Edwards, in further view of U.S. Appl. Pub. No. 2003/0175328 to Shefer et al. ("Shefer"). Claims 21 and 26 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable in view of Muchin, Edwards in further view of United States Patent No. 5,167,649 to Zook. ("Zook"). Claim 32 stands rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable in view of Muchin, Edwards, in further view of United States Patent No. 6,103,275 to Seitz et al.

("Seitz"). In view of the above amendments, Applicants traverse these rejections.

Claims 1, 2, 4, 5, 10-12, 16-20, 22, 23, 25, 28, 39, and 42-45 are cancelled and therefore, the rejections thereof are rendered moot.

Claim 30 was amended to recite a method reducing skin exposure to ultraviolet (UV) radiation, comprising the steps of: i) providing a patch capable being applied to skin for reducing exposure to ultraviolet (UV) radiation, wherein the patch includes a first layer that is adhesive and a second layer adjacent to the first layer comprising a material and one or more UVA (320 – 400 nm) radiation blocking agents and one or more UVB (280 – 320 nm) blocking agents, wherein the second layer is transparent such that the skin is visible through the patch; and wherein the patch comprises a UV protection factor (UPF) of at least 15; and applying the patch to the skin with the adhesive layer contacting the skin wherein the patch is applied to an area of skin selected from the group consisting of: a melanoma; a mole and the area of skin around the mole; freckles; dysplastic nevi; a cancerous tumour; basal cell carcinoma; squamous cell carcinoma; particular areas of skin prone to sunburn rather than suntan; an actinic keratosis; an intra epidermal carcinoma (Bowens Disease); a skin ulcer; eczema; an area of dry skin; and an area of skin that does not heal. Claims 31-36, 38, and 44-86 depend directly or indirectly from Claim 30, and thus incorporate each and every feature of claim 30.

To establish a *prima facie* case of obviousness, the Patent Office must show, *inter alia*, that the cited references teach or suggest all the claim limitations or otherwise provide a *KSR* rationale as to why the skilled artisan would modify the prior art to arrive at the claimed invention. Manual of Patent Examination and Procedure (M.P.E.P.) § 2143.03; *In re Royka*, 490 F.2d 981 (C.C.P.A. 1974). Additionally, the Office must consider, "(1) whether the prior art would have suggested to those of ordinary skill in the art that they should make the claimed composition or device, or carry out the claimed process; and (2) whether the prior art would also have revealed that in so making or carrying out, those of ordinary skill would have a reasonable expectation of success." *In re Vaeck*, 947 F.2d 488, 493 (Fed. Cir. 1991); *see also Dystar Textilfarben GmbH & Co. Deutschland Kg v. C.H. Patrick Co.*, 464 F.3d 1356, 1360 (Fed. Cir. 2006). It is improper to merely identify elements in various cited references, because doing so "would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention." *See In re Rouffet*, 149 F.3d 1350, 1357-58 (Fed. Cir. 1998). Furthermore, the Supreme Court noted that the analysis supporting a rejection under 35 U.S.C. § 103(a) should be made explicit, and that it is

"important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements in the way the claimed new invention does." *KSR International v. Teleflex, Inc.*, 127 S.Ct. 1727, 1741 (2007).

As discussed during the Examiner interview, Muchin nor Edwards disclose a patch comprising a first layer that is an adhesive and as second layer adjacent to the first layer comprising a material and one or more UVA (320-400 nm) radiation blocking agents and one or more UVB (280-320 nm) blocking agents, wherein the second layer is transparent such that the skin is visible through the patch, and wherein the patch comprises a UV protection factor of at least 15.

Rather Muchin discloses a patch for the removal of keratotic plugs from the skin (Muchin, col. 3, ll. 62-63), whereas Edwards discloses textiles comprising ultraviolet blocking particles.

Furthermore, neither Muchin nor Edwards disclose a method of applying the patch to an area of the skin selected from the group consisting of: a melanoma; a mole and the area of skin around the mole; freckles; dysplastic nevi; a cancerous tumour; basal cell carcinoma; squamous cell carcinoma; particular areas of skin prone to sunburn rather than suntan; an actinic keratosis; an intra epidermal carcinoma (Bowens Disease); a skin ulcer; eczema; an area of dry skin; and an area of skin that does not heal.

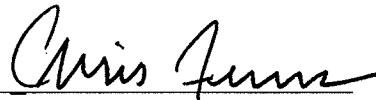
Accordingly, Muchin and Edwards do not teach or disclose each and every feature of the presently claimed invention. Furthermore, applicants respectfully submit that the Office has merely identified various elements in the cited references while using the presently claimed invention as a blueprint. Such picking and choosing amounts to impermissible hindsight, because the Office has not pointed to any portion of the cited references that would have motivated one of skill in the art to combine Muchin and Edwards. Accordingly, one of skill in the art would not have had a reasonable expectation of success in arriving at the presently claimed invention without the benefits of impermissible hindsight.

D. Conclusion

In view of the above amendments and remarks, it is believed that this application is in condition for allowance, and a Notice thereof is respectfully requested.

Applicant's undersigned attorney may be reached in our Washington, D.C. office by telephone at (202) 625-3647. All correspondence should continue to be directed to the below-listed address.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Chris Ferenc", written over a horizontal line.

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